



Attorney Docket No. 45858/56066

GP/1634

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OCT 25 2002

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Philpott et al. Art Unit: 1634  
U.S.S.N.: 09/993,736 Examiner: J. Goldberg  
FILED: November 14, 2001  
FOR: SAMPLING AND STORAGE SYSTEM FOR GENETIC MATERIAL FROM  
TISSUE

**CERTIFICATE OF MAILING**

I hereby certify this correspondence and the documents referred to as attached herein are being deposited with the United States Postal Service as First Class Mail addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on October 17, 2002.

By: Regina M. Edwards  
Regina M. Edwards

Commissioner of Patents  
Washington, D.C. 20231

**TRANSMITTAL LETTER**

Transmitted herewith for filing in the above-referenced patent application are the following documents:

- 1) Response to Restriction Requirement (2 pages);
- 2) Petition for One-Month Extension of Time (2 pages);
- 3) Check in the amount of \$110.00 for One-Month Extension;
- 4) Copy of September 9, 2002 Office Action (5 pages);
- 5) This transmittal letter (x2); and
- 6) Return postcard.

The Commissioner is hereby authorized to charge any excess fees that may be required, or credit any overpayment to Deposit Account No. 04-1105. A duplicate copy of this sheet is enclosed.

Date: October 17, 2002

Respectfully submitted,  
Kathryn A. Piffat, Ph.D.  
Kathryn A. Piffat, Ph.D. (Reg. No.: 34,901)  
Dike, Bronstein, Roberts & Cushman  
Intellectual Property Practice Group of  
Group of EDWARDS & ANGELL, LLP  
P.O. Box 9169  
Boston, Massachusetts 02209



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.....  
**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 October 17, 2002.

By:

Regina M. Edwards  
Regina M. Edwards

.....  
**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the restriction requirement of September 9, 2002, Applicants hereby elect Group I, which presently includes claims 1-4 and 6-32, with traverse.

The present election is made solely to comply with the restriction requirement set forth in the Office Action. It should not be construed as a disclaimer or surrender of any subject matter in the application. The right to file one or more divisional applications on the non-elected claims is reserved.

Applicants respectfully request reconsideration of the Restriction Requirement as set forth. For example, it is believed that no undue burden would be imposed by examination of the four groups, because searches for these groups would overlap significantly. In addition, Applicants would like to draw the Examiner's attention to the language of the claims in Groups II, III, and IV (and especially in Group II) concerning "the genetic material." Accordingly, it is requested that the restriction requirement be reconsidered.

Applicants believe that only a one-month extension of time is required, because this Response is being filed within one month after the expiration of the specified one (1) month period. Applicants petition for a one-month extension of time and include payment of fees for the one-month extension of time. If an additional extension is needed, applicants hereby conditionally petition for an extension of time to provide for the possibility that the need for such a petition has been inadvertently overlooked.

Although it is not believed that any additional fees are needed to consider this submission, the Examiner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,



Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)

Edwards & Angell

Dike, Bronstein, Roberts & Cushman

Intellectual Property Practice Group

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Date: October 17, 2002

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## UNITED STATES PATENT AND TRADEMARK OFFICE

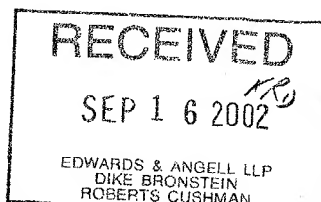
UNITED STATES DEPARTMENT OF COMMERCE  
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Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,736	11/14/2001	Richard Philpott	56066/45858	9454

7590 09/09/2002  
DBRC, IPPG of EDWARDS & ANGELL, LLP  
P.O. Box 9169  
Boston, MA 02209

EXAMINER	
GOLDBERG, JEANINE ANNE	
ART UNIT	PAPER NUMBER
1634	

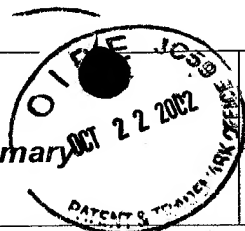
DATE MAILED: 09/09/2002



Please find below and/or attached an Office communication concerning this application or proceeding.

*Restriction*  
Edwards & Angell LLP  
Dike, Bronstein, Roberts & Cushman  
101 Federal St. Boston, MA 02110  
Date Rec'd 9/16/02  
Docketed For Oct. 9, 2002 - Feb. 9, 2003  
By LRD  
Approved m 9/16/02

## Office Action Summary



Application No.

09/993,736

Examiner

Jeanine A Goldberg

Applicant(s)

PHILPOTT ET AL.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 6-32, drawn to methods of genetic analysis, classified in class 435, subclass 4.
  - II. Claim 5, drawn to a kit comprising a means for processing and a matrix, classified in class 435, subclass 287.7.
  - III. Claim 33, drawn to a kit containing solid medium for retaining cells and second solid medium with a matrix comprising a composition, classified in class 435, subclass 287.9.
  - IV. Claim 34, drawn to an apparatus comprising a chamber, vacuum and a matrix, classified in class 435, subclass 283.1.
2. The inventions are distinct, each from the other because of the following reasons:
  - A) Inventions (II and III) and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products, namely groups II and III may be used in material different methods from the method of Group I. The kits may be used for isolating nucleic acids, cells, proteins; analyzing

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genetic material, purifying genetic material or merely storing genetic material for later analysis.

B) The kits of Group II and III are distinct kits. Each kits contains different components which are not obvious over the other.

C) The kits of Group (II and III) are distinct from the apparatus of Group IV. The apparatus contains several elements which are not required by either of the kits such that the apparatus is distinct from the kits.

D) Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus may be used for a material different method. For example the chamber, vacuum and matrix may be used for generating a matrix comprising genetic material for further storage, for example. The apparatus does not have to be for isolating genetic material.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

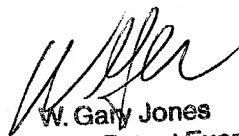
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of formal matters can be directed to the patent analyst, Pauline Farrier, whose telephone number is (703) 305-3550.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Jeanine Goldberg  
September 4, 2002

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600